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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/608,315      | 06/26/2003  | Hong Wang            | 42P13148            | 8011             |

8791 7590 03/27/2006

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EXAMINER

TREAT, WILLIAM M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2181

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/608,315             | WANG ET AL.         |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | William M. Treat       | 2181                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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1. Claims 1-29 are presented for examination.
2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. Applicants have described source code as a high-level language which requires compiling into macroinstructions or, potentially, microinstructions. They do not discuss how one might use a file (first code) of high-level language and macroinstructions.

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 8-10, 17-19, and 22-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
7. Claims 8-10, 17-19, and 22-24 are for instructions/programs merely stored on a computer readable medium without being executed on computer. Given today's computer system capabilities applicants could merely have a paper printout of a program printed with an OCR font (i.e., it would be a computer-readable medium storing applicants' program but not a patentable invention).

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8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-2, 7, 17-18, 22-23, 25-26, and 28-29 are rejected under 35

U.S.C. 102(b) as being clearly anticipated by Johnson (Patent No. 5,253,308).

10. The examiner would suggest applicants read col. 19, line 35 through col. 20, line 11, at a minimum, before responding. When reading, remember having all the second code be microinstructions means there are microinstructions for at least some portions of the first code. The examiner considers the processor and memory of the latter claims to be inherent in any system running Johnson's cross-compiler.

11. Claims 1-4, 7, 14-15, 17-19, 22-23, 25-26, and 28-29 are rejected under 35

U.S.C. 102(b) as being clearly anticipated by Gee et al. (Patent No. 6,317,872).

12. The examiner would suggest applicants read col. 2, lines 42-51; col. 7, lines 29-43; col. 8, line 25 through col. 9, line 21; col. 11, lines 32-44; and col. 16, lines 47-67, at a minimum, before responding. Note that the examiner has interpreted "analyzing" to be either "compiling" (col. 2, lines 42-51) and/or translating (col. 8, lines 65-67) and/or substituting (col. 16, lines 56-67) as was appropriate to the limitations of applicants' various claims. Also, having all the second code be microinstructions or JAVA byte codes means there are microinstructions or JAVA byte codes for at least some portions of the first code.

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13. Claims 1-7, 11-15, 17-23, 25-26, and 28-29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bullions, III et al. (Patent No. 5,280,593).

14. The examiner would suggest applicants read col. 4, line 60 through col. 6, line 22; col. 8, line 62 through col. 9, line 25; and col. 10, lines 45-63, at a minimum, before responding. Note that the examiner recognizes that some programs written in 390 instructions (i.e., CISC/macroinstructions) may be programmer-coded, but it is also inherent that some would have resulted from and did result from compilation of a higher-level language into 390 instructions. Once again, the examiner has interpreted "analyzing" to reflect the task of converting to 390 instructions, some of which can be directly executed, and or the task of interpreting more complex 390 instructions into millicode instructions. Note also that the examiner considers the ISA format boundary markers and trigger to be the instructions the detection logic (120) recognizes to then flip the decoder between 390 mode and millimode.

15. Claims 14-16 and 22-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Brown et al. (Patent No. 5,537,629).

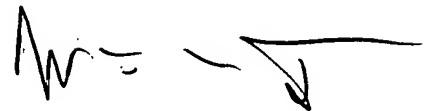
16. The examiner would suggest applicants read the Background of the Invention, at a minimum, before responding.

17. Any inquiry concerning this communication should be directed to William M. Treat at telephone number (571) 272-4175. The examiner works at home on Wednesdays but may normally be reached on Wednesdays by leaving a voice message using his office phone number. The examiner also works a flexible schedule but may

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normally be reached in the afternoon and evening on three of the four remaining weekdays.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**WILLIAM M. TREAT  
PRIMARY EXAMINER**